

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number 24207-10095	
Pursuant to 240 OG 45 and the <i>Legal Framework For EFS-Web</i> , I hereby certify that this follow-on correspondence is being officially submitted through the USPTO EFS-Web system from the Pacific Time Zone of the United States on the local date shown below. on <u>May 27, 2008</u>		Application Number 10/749,434	
Signature <u>/Christopher King/</u>  Typed or printed name <u>Christopher-Charles P. King</u>		Filed December 31, 2003  First Named Inventor Stephen R. Lawrence  Art Unit 2161	
Examiner Paul Kim			
<p>This request is being filed with a notice of appeal.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest.            See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.         </div> <div style="width: 50%;"> <u>/Christopher King/</u>   <u>Christopher-Charles P. King</u>  <small>Typed or printed name</small> </div> </div> <div style="display: flex; justify-content: space-between; margin-top: 10px;"> <div style="width: 45%;"> <input checked="" type="checkbox"/> attorney or agent of record.            Registration number <u>60,985</u> </div> <div style="width: 50%;"> <u>(650) 335-7633</u>  <small>Telephone number</small> </div> </div> <div style="display: flex; justify-content: space-between; margin-top: 10px;"> <div style="width: 45%;"> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.            Registration number if acting under 37 CFR 1.34 _____         </div> <div style="width: 50%;"> <u>May 27, 2008</u>  <small>Date</small> </div> </div>			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".			
<input checked="" type="checkbox"/> *Total of <u>1</u> of <u>1</u> form is submitted.			

## **ATTACHMENT TO THE PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Pre-appeal review is requested because the rejections in the Final Office Action of December 27, 2007 are improper and without factual or legal basis. Applicants respectfully request that the Panel indicate that claim 105 recites allowable subject matter.

### **I. Status of the Claims**

Claims 25, 26, 54, 55, and 62-105 are pending in this application. Claims 25-26, 54-55, 62-63, 71, 80, 83-84, 92, 101, and 104-105 stand rejected under 35 USC § 102(b) as allegedly being anticipated by Uchiyama, U.S. Patent Application Publication No. 2002/0065802. Claims 64-70, 72-79, 81-82, 85-91, 93-100, and 102-103 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over Uchiyama in view of Official Notice.

### **II. Rejection of claim 105 under 35 USC §102(b) as allegedly anticipated by Uchiyama**

Preliminarily, note that in an anticipation rejection under §102, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), cited in MPEP §2131. In order for an element to be inherently described, it must be clear that the element is necessarily present in the thing described in the reference. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)

Generally, independent claim 105 is directed towards arranging articles in search results

based on a predetermined client behavior score calculated based on client-side behavior data associated with an article on a client device. This involves determining client side behavior data associated with the article on the client device, and storing the calculated score in a data store in the client device. Specifically, claim 105 recites a method to order search results, comprising:

**determining client-side behavior data associated with an article stored in a client device;**  
providing the client-side behavior data associated with the article to a ranking processor;  
calculating a predetermined client behavior score for the article based at least in part on the client-side behavior data associated with the article;  
storing the predetermined client behavior score **in a data store in the client device**, wherein the data store associates the predetermined client behavior score with the article;  
...

Thus, claim 105 specifically recites “determining client-side behavior data associated with an article stored in a client device” and “storing the predetermined client behavior score in a data store in the client device.” Thus, both the article with which the behavior data is associated, and the data store storing the predetermined client behavior store, are stored in a client device. This enables, for example, the ability to do quick and effective searches of the local client system based on the client-side behavior data.

The applied reference, Uchiyama, deals with monitoring a user’s browsing activity with respect to remote web sites and aggregating the resulting data on a server. (*See, e.g.*, Uchiyama paragraph 0012, which states that “[d]uring the aggregation process, data collected by the distributed monitoring system are categorized and organized **in a central database** for convenient retrieval”). However, as discussed further below, it does not disclose the claimed uses of the client device.

In the Final Office Action of December 27th, the Examiner grouped claim 105 with claims 25, 54, and 104 and rejected all four claims as allegedly anticipated by Uchiyama based

on an analysis of claim 25. However, neither claims 25, 54, nor 104 recited the client device features at issue. In a Request for Reconsideration submitted March 17, 2008, Applicants noted that because Uchiyama aggregates client-side data relating to remote web sites on a server, it therefore fails to determine behavior data *associated with an article stored in a client device* and to store a score *in a data store in the client device*, as claimed.

In response, the Examiner issued an Advisory Action on May 21, 2008, replying that “the article and the client-side behavior may be stored in the central server (i.e. a client device).” However, such an interpretation fails to support a rejection under § 102 for several reasons. First, the central server of Uchiyama does not constitute the claimed “client device,” and interpreting it to do so fails to accord patentable weight to the “client device” element. Uchiyama’s central server does not request information from other systems, as does a prototypical client, but rather accepts data, such as browsing data, transmitted to it by clients, recording, categorizing, and aggregating the data. (*See, e.g.*, Uchiyama paragraph 0059). These are not the actions of a client under any reasonable interpretation.

Second, even if the Uchiyama central server were accepted to be a “client device,” it would still not store an article with which client-side behavior data is associated, as claimed. Indeed, Uchiyama nowhere discloses that it does so. Rather, the only discussion of the Uchiyama central server relates to its data aggregating function, i.e. collecting and processing the data monitored on the client side. In each of Uchiyama’s Figures 1-4, it is depicted as separate and distinct from e.g. web sites, web servers, and other devices storing articles. Nor is it inherent that the Uchiyama central server stores such articles, since there is no reason that it would necessarily do so. Indeed, since the only noted purpose of the Uchiyama central server is to aggregate data on browsing or other usage data, it would be entirely unnecessary for it to

additionally store the actual articles with which client-side behavior data is associated. Thus, since it is neither express nor inherent that the Uchiyama central server stores an article with which client-side behavior data is associated, the rejection under § 102 is legal error.

### **III. Summary**

Based on the foregoing, Applicants respectfully submit that the pending rejection suffers from a clear deficiency. Accordingly, Applicants request that the rejection of claim 105 be withdrawn.

Respectfully Submitted,  
STEPHEN LAWRENCE ET AL.

Date: May 27, 2008

By: /Christopher King/

Christopher P. King, Reg. No. 60,985  
Attorney for Applicants  
FENWICK & WEST LLP  
801 California Street  
Mountain View, CA 94041  
Phone: (650) 335-7633  
Fax: (650) 938-5200